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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,450	08/21/2003	David Rizzo	DRIZZO 3.0-001 RE	7979
530	7590	12/02/2005	EXAMINER	
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			PHAM, HUNG Q	
			ART UNIT	PAPER NUMBER
			2168	

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/645,450

Applicant(s)

RIZZO ET AL.

Examiner

HUNG Q. PHAM

Art Unit

2168

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 1-34 are pending in this Reissue Application. As set forth in the Petition Decision 03/16/2005, a copy of U.S. Patent No. 6,470,338 will be used for examination purposes.

#### ***Claim Objections***

Claims 1, 14, 21, 22 and 32 objected to because of the following informalities: *said electronic message* (*said electronic message* should be changed to *said electronic mail message* to have a consistency of terminology). Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1- 21 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility.**

As in independent claims 1, 14 and 21, the claimed *presenting a first electronic document including a plurality of data entry devices* is inoperative because data entry devices are hardware, and hardware cannot be included in an electronic document, e.g., HTML document.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 1, 14, 17 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.**

As in claims 1, 14 and 21, the claimed *presenting a first electronic document including a plurality of data entry devices, and automatically providing information indicative of another portion of received data to each responding one of service providers* were not described in the specification in such a way as to enable one skilled in the art to which it pertains to make and/or use the invention. In short, data entry devices are hardware, and hardware cannot be included in an electronic document, e.g., HTML document.

As in claim 17, the claimed *after a given time period, said application selectively automatically makes at least a portion of said stored information available to each of said service providers based upon said stored information* was not described in the specification in such a

way as to enable one skilled in the art to which it pertains to make and/or use the invention.

As in claim 21, the claimed *after a given time period, said application automatically generates and transmits via said computer network an electronic mail message to said identified one or more service providers, said electronic message including information indicative of a portion of said received data* was not described in the specification in such a way as to enable one skilled in the art to which it pertains to make and/or use the invention.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claim 1-11, 13-18, 20-32 and 34 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Walker et al. [USP 5,862,223].**

Regarding claim 1, Walker teaches *a computerized method for matching potential clients with professional services providers which meet their personalized criteria and are interested in providing particular services to them* (Walker, Abstract), the method comprising the steps of:

*presenting a first electronic document including a plurality of data entry devices to potential clients via a computer network* (Walker, Col. 25, Lines 20-34);

*receiving data entered using data entry devices, received data being indicative of criteria* (Walker, FIG. 6, Col. 17, Lines 13-35);

*automatically comparing received data to data stored in a storage medium to identify one or more suitable professional services providers based upon criteria* (Walker, Col. 20, Lines 28-49);

*automatically generating and transmitting an electronic mail message to identified one or more service providers via computer network, electronic message including information indicative of a portion of received data* (Walker, Col. 21, Lines 12-26, Col. 7, Lines 47-53); and

*receiving a response from at least one responding one of one or more identified service providers* (Walker, Col. 21, Lines 35-36), and

*automatically providing information indicative of another portion of received data to each responding one of service providers* (Walker, Col. 21, Lines 35-37, Col. 7, Lines 53-57).

Regarding claim 14, Walker teaches *a system for matching potential clients with professional services providers which meet their personalized criteria and are interested in providing particular services to them* (Walker, Abstract). The Walker system comprising:

*at least one server being communicable via a computer network* (Walker, FIG. 2, Col. 13, Lines 30-34) ;

*an application executed by said at least one server* (Walker, FIG. 6, Col. 16, Line 62-Col. 20, Line 27);

*a storage medium accessible by both said application and server* (Walker, FIG. 2, Col. 14, Lines 14-24); and,

*a plurality of suitable microprocessor based devices being communicable with said at least one server via said computer network* (Walker, Col. 16, Lines 1-26);

*wherein, said application is responsive to requests received by said at least one server from at least one of said suitable microprocessor based devices to present at least one electronic document including a plurality of data entry devices to said microprocessor based devices via said computer network* (Walker, Col. 25, Lines 20-34);

*wherein, said server receives data entered using said data entry devices and stores said data in said storage medium, said received data being indicative of said criteria* (Walker, FIG. 6, Col. 17, Lines 13-35);

*wherein said application automatically compares said received data to said stored data to identify one or more suitable professional services providers* (Walker, Col. 20, Lines 28-49);

*wherein said application automatically generates and transmits via said computer network an electronic mail message to said identified one or more service providers, said electronic message including information indicative of a portion of said received data* (Walker, Col. 21, Lines 12-26, Col. 7, Lines 47-53); and,

*wherein when said server receives a response from at least one responding one of said one or more identified service providers* (Walker, Col. 21, Lines 35-36), said

*application automatically provides information indicative of another portion of said received data to said responding one of said service providers via said computer network* (Walker, Col. 21, Lines 35-37, Col. 7, Lines 53-57).

Regarding claim 21, Walker teaches *a system for matching potential clients with professional services providers which meet their personalized criteria and are interested in providing particular legal services to them*. The Walker system comprising:

*at least one server being communicable via a computer network* (Walker, FIG. 2, Col. 13, Lines 30-34) ;

*an application executed by said at least one server* (Walker, FIG. 6, Col. 16, Line 62-Col. 20, Line 27);

*a storage medium accessible by both said application and server* (Walker, FIG. 2, Col. 14, Lines 14-24); and,

*a plurality of suitable microprocessor based devices being communicable with said at least one server via said computer network* (Walker, Col. 16, Lines 1-26);

*wherein, said application is responsive to requests received by said at least one server from at least one of said suitable microprocessor based devices to present at least one electronic document including a plurality of data entry devices to said microprocessor based devices via said computer network* (Walker, Col. 25, Lines 20-34);

*wherein, said server receives data entered using said data entry devices and stores said data in said storage medium, said received data being indicative of said criteria* (Walker, FIG. 6, Col. 17, Lines 13-35);



*wherein said application automatically compares said received data to said stored data to identify one or more suitable professional services providers (Walker, Col. 20, Lines 28-49);*

*wherein after a given time period, said application automatically generates and transmits via said computer network an electronic mail message to said identified one or more service providers, said electronic message including information indicative of a portion of said received data (Walker, Col. 21, Lines 12-37, Col. 7, Lines 47-53); and,*

*wherein when said server receives a response from at least one responding one of said one or more identified service providers (Walker, Col. 21, Lines 35-36), said*

*application automatically provides information indicative of another portion of said received data to said responding one of said service providers via said computer network (Walker, Col. 21, Lines 35-37, Col. 7, Lines 53-57).*

Regarding claim 22, Walker teaches *a computerized method for matching potential clients with professional services providers which meet their personalized criteria and are interested in providing particular services to them* (Walker, Abstract), the method comprising the steps of:

*presenting a first electronic document to potential clients via a computer network (Walker, Col. 25, Lines 20-34);*

*receiving data entered using data entry devices, received data being indicative of criteria (Walker, FIG. 6, Col. 17, Lines 13-35);*

*automatically comparing received data to data stored in a storage medium to identify one or more suitable professional services providers based upon criteria (Walker, Col. 20, Lines 28-49);*

*automatically generating and transmitting an electronic mail message to identified one or more*

*service providers via computer network, electronic message including information indicative of a portion of received data* (Walker, Col. 21, Lines 12-26, Col. 7, Lines 47-53); and

*receiving a response from at least one responding one of one or more identified service providers* (Walker, Col. 21, Lines 35-36), and

*providing information indicative of another portion of received data to each responding one of service providers* (Walker, Col. 21, Lines 35-37, Col. 7, Lines 53-57).

Regarding claims 2 and 23, Walker teaches all the claim subject matters as discussed above with respect to claims 1 and 22, Walker further discloses *an electronic document includes Hypertext Markup Language (HTML) information* (Walker, Col. 25, Lines 20-52).

Regarding claims 3 and 24, Walker teaches all of the claimed subject matter as discussed above with respect to claims 2 and 23, Walker further discloses *computerized network includes a global interconnection of computers and computer networks* (Walker, Col. 13, Lines 9-61).

Regarding claims 4, 20 and 25, Walker teaches all of the claimed subject matter as discussed above with respect to claims 3, 14 and 24, and the description of Col. 25, Lines 20-52 implies *received data was entered using a commercially available browser software package* (either Internet Explorer or Netscape is used for browsing).

Regarding claims 5 and 26, teaches all of the claimed subject matter as discussed above with respect to claims 1 and 22, Walker further discloses the step of *checking received data to confirm it is in a proper format* (Walker, Col. 19, Lines 25-28).

Regarding claims 6 and 27, Walker teaches all of the claimed subject matter as discussed above with respect to claims 1 and 22, Walker further discloses the step of *storing data indicative of plurality of service providers on storage medium* (Walker, Col. 14, Lines 25-41).

Regarding claims 7 and 28, Walker teaches all of the claimed subject matter as discussed above with respect to claims 1 and 22, Walker method further comprising the step of *automatically storing received data on storage medium* (Walker, Col. 19, Lines 1-3).

Regarding claims 8, 18 and 29, Walker teaches all of the claimed subject matter as discussed above with respect to claims 7, 14 and 28, Walker further discloses *received data includes information indicative of information selected from the group consisting of a service provider size, a service provider specialty, a location of services to be provided, an estimated budget for services to be provided and a general description of services to be provided* (Walker, Col. 17, Lines 13-35).

Regarding claims 9 and 30, Walker teaches all of the claimed subject matter as discussed above with respect to claims 8 and 29, the Walker method further comprising *assigning a unique identifier to each of received data* (Walker, Col. 17, Lines 7-12).

Regarding claims 10 and 31, Walker teaches all of the claimed subject matter as discussed above with respect to claims 9 and 30, Walker further discloses *received data and unique number are stored in a record* (Walker, Col. 17, Lines 7-12).

Regarding claims 11 and 32, Walker teaches all of the claimed subject matter as discussed above with respect to claims 10 and 31, Walker further discloses *unique number is included in electronic message* (Walker, Col. 18, Lines 54-60).

Regarding claims 13, 15 and 34, Walker teaches all of the claimed subject matter as discussed above with respect to claims 1, 14 and 22, Walker further discloses *professional services are legal services* (Walker, Col. 19, Lines 29-45).

Regarding claim 16, Walker teaches all the claim subject matters as discussed above with respect to claim 14, Walker further discloses *a portion of said stored data is not accessible to said service providers* (Walker, FIG. 25, Col. 31, Lines 1-23).

Regarding claim 17, Walker teaches all the claim subject matters as discussed above with respect to claim 14, but does not explicitly teach the claimed *wherein after a*

*given time period, said application selectively automatically makes at least a portion of said stored information available to each of said service providers based upon said stored information.* However, a user request can be put on a bulletin board (Walker, Col. 18, Lines 43-44), user's request is stored in a database (Walker, Col. 19, Lines 10-12), and a user has to resubmit a request within a given time period if there is no acceptance (Walker, Col. 21, Lines 31-35). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Walker technique by making the stored request available using the bulletin board in order to look for an expert.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 12, 19 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. [USP 5,862,223] in view of Sutcliffe et al. [USP 6,052,122].**

Regarding claims 12, 19 and 33, Walker teaches all of the claimed subject matter as discussed above with respect to claims 1, 14 and 22, but fails to teach the step of *comparing comprises periodically querying said storage medium*.

Sutcliffe teaches the technique of *periodically querying said storage medium* (Sutcliffe, Col. 8, Lines 2-5).

It would have been obvious for one of ordinary skill in the art at the time the invention was made to search the database periodically as taught by Sutcliffe in order to match a user with a right expert.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUNG Q. PHAM whose telephone number is 571-272-4040. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JEFFREY A. GAFFIN can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
HUNG Q PHAM  
Examiner  
Art Unit 2168

November 18, 2005